

The present case rests at the threshold of a Petition to the Commissioner of Patents to exercise the Commissioner's supervisory authority to instruct and require that the Examination fulfill the examining obligations as dictated under the M.P.E.P.

Applicant's attorney has more than four decades of experience within the field of patent application prosecution at and before the U.S. Patent and Trademark Office. I have served as an Examiner; and was recognized as the top graduate of the United States Patent Office Training Academy. I had been asked to serve a clerkship at Court of Customs and Patent Appeals for the then Chief Judge Worley, but chose not to do so. I have seen and responded to thousands of office actions and throughout the years have been reluctant to speak out when injustices occur within the system. As a registered patent attorney, I am required to follow the Rules of Practice and M.P.E.P. to ensure that my client's interests are best served thereby. I must advise my clients as to potential patentability of claimed invention under the existing facts of record in view of the controlling legal principles. By the same token, the U.S. Patent & Trademark Office is charged with the responsibility of following those guidelines as established by the M.P.E.P. so that there is consistency in the patentability standards and to ensure that uniform justice and practice is granted to all applicants. On an occasion, I have found it necessary to successfully petition to the Commissioner of Patents to exercise supervisory authority under circumstances in which I felt that the Rules of Practice as established by the M.P.E.P., Statutes and the Constitutional provisions were not being followed. I consider myself at that threshold in this case.

The Office Action lacks all those prerequisite facts, as well as those legal principles upon which to predicate a *prima facie* case of obviousness rejection of Applicant's claims 1-15. All applicants are entitled to an unbiased adjudication and presentation of those facts upon which any 35 U.S.C. 103 rejection may be properly based. It is an essential prerequisite for all 35 U.S.C. 103 rejections that the prior art fairly teach and suggest the claimed invention without any reliance upon Applicant's inventive contribution to establish untaught facts as well as sufficient guidance to enable the artisan of ordinary skill to make and use the invention as claimed by the Applicant. It is also an essential prerequisite of any 103 rejection that all claimed limitations of any rejected

claim must be taught by a fair appraisal of those teachings which are relied upon in the 35 U.S.C. 103 rejection. It is axiomatic under any 35 U.S.C. 103 rejection that the references must be reviewed in their entirety for what each reference teaches. It is completely impermissible to disregard teachings in a cited reference which are totally contradictory to the manner in which the references are combined with one another in the rejection. If a reference teaches that a certain result cannot be achieved using what is alleged to be an equivalent, the reference cannot be regarded to be suggestive of something that cannot be accomplished. It is also self-evident that references when they are applied to the 103 rejection in a reference combination may not be modified to such an extent that the modification renders the reference or patent inoperable for its intended purpose or function. Results in view unachievable teachings pursuant to a reference is unexpected. These obviousness standards have not been applied to the final rejection of record.

An applicant should not be exposed to undue prosecution expenses for a claimed invention which is clearly distinguishable and patentable over the art of record. The art founded want for an appropriate factual basis for rejecting Applicant's claims is often disguised by an unwarranted assertion of inherency or an alleged admission of equivalency. There should be no doubt on this record that the Applicant has never stated that the unique ball retrieving attachment of uniquely different hooking materials as prescribed by Applicant's claims herein are the equivalents to what the Office Action alleges in the Final Rejection. There would have been no need for the Applicant to file her (not his) application and claim a unique and unexpected phenomena heretofore unknown if, in fact, the Applicant deemed that the ball retrieving attachment of the prior art to be the obvious and actual equivalents of Applicant's ball retrieving attachment characterized by having a very narrowly defined, unusual, atypical and precise group of the Applicant's claimed hooked fastener materials as used herein.

FACTUAL RESOLUTION

Before there can be any resolution of the 35 U.S.C. 103 issues herein, it is first necessary to establish Fact from Fiction. The following facts are clearly elucidated by each of the cited patent teachings as a whole. The facts are as follows:

Feldi Facts

1. **FACT** - The primary reference *Feldi* states that, "a hook material (ex. Velcro) when affixed to the end of a tennis ball racket ""does not effectively pick up a" standard tennis ball with this system", and that the standard material is not compatible with the hook fastener system... in that, "the hooked material destroys the tennis ball covering."
2. **FACT** - a Velcro hook material of the type as tested and described by *Feldi* does not work (via tangential contact) upon the tennis ball felt cover as claimed.
3. **FACT** - The *Feldi* solution to the problem is to eliminate the tennis ball pile covering by replacing the pile covering with one of a nylon Velcro loop fastener combination so that the Velcro hook will then hook and fasten onto the nylon loop or hook ball covering. (Both the hook and loop must be used to work.)
4. **FACT** - Applicant's claims recite a ball retrieving attachment "for engaging and lifting a grounded *tennis ball* upon **tangential contact** with said *tennis ball* ... for engaging and lifting the grounded *tennis ball* upon tangential contact with said hooks."
5. **FACT** - The altered ball of *Feldi* is not a tennis ball, since a tennis ball by standard of identity "must be covered with felt." Felt is notoriously known and defined ¹ as "a cloth or fabric made of wool, or of wool and fur or hair." Neither the Velcro hook nor loop material of *Feldi* is of wool. Therefore, the altered ball of *Feldi* is not a tennis ball and does not meet the claimed "tennis ball" requirements of Applicant's claims. (Applicant encloses herewith Wilson Sporting Good's response to tennis ball standards ²).
6. **FICTION** - There is no basis, in fact, for the speculative conclusion that "the claims do not preclude changing the tennis ball pile and the *Feldi* racket itself, as modified above, would inherently function as recited." Inherency does not apply since inherency must be proven and

1. Webster's New Universal Unabridged Dictionary Deluxe, Second Edition 1983

2. Wilson Sporting Goods defines a tennis ball as having a wool pile cover.

requires identity of substance, (also the retrieval with a ball retrieving attachment involves a tennis ball vs. a non-tennis ball).

7. **FACT** - Applicant's claims prescribe a tennis ball and, therefore, the non-tennis ball teachings of *Feldi* is precluded by Applicant's claims.

8. **FACT** - *Feldi* neither discloses nor remotely suggests "a ball retrieving attachment attached to a shoulder of the racquet in ball retrieving position" of "a series of preshrunken nylon monofilament hooks... having a monofilament diameter great than 8.0 mil and an average hook height of at least 1.70 mm." which upon tangential contact with the tennis ball felt cover engages the pile and thereupon allows the ball to be lifted thereby. *Feldi* states unequivocally that the Velcro monofilament hook materials of the type known and understood by *Feldi* do not work.

9. **FACT** - Two significant and material claimed limitations (i.e. tennis ball) *tangentially engaging and lifting a standard tennis ball* (i.e. wool pile) with a very narrowly defined and precise hooked material (Claim 1 diameter greater than .8 mil, average height at least 1.70 mm; Claim 10 diameter at least 8.0 mil, average hook height at least 1.85 mm; average width at least 1.0 mm; and average depth at lest .6 mm and at least 250 hooks per square inch of spiral configuration arranged in repetitive rows "are neither disclosed nor remotely contemplated by *Feldi* or any other cited patent of record."

10. **FACT** - Applicant's results are completely unexpected in light of *Feldi*'s prior art teaching that a Velcro hook material does not work and the need to completely replace the tennis ball pile covering with a Velcro loop covering or vice verse.

11. **FACT** - An essential embodiment of *Feldi* is to change the ball covering to a Velcro loop (or hook) material and, therefore, no longer be recognized as a tennis ball which definition precludes a ball having a Velcro loop or hook covering.

12. **FACT** - The *Feldi* patent teachings cannot be applied against Applicant's claims without first destroying the basic and novel teachings (i.e. replace wool pile covering with Velcro), as well as the essence of the *Feldi* patent.

13. **FACT** - In combining the *Feldi* patent teachings with any of the other cited patents, an essential *Feldi* teaching must be totally disregarded and discarded, namely you must change the tennis ball cover to either a hook or loop Velcro material which *ipso facto* renders the *Feldi* teaching inoperable and unfit for its intended function and purpose if, in fact, the cover remains unchanged.

14. **FICTION** - The final rejection assertion that the Velcro hook material as defined and used by the *Feldi* is an equivalent to the narrowly defined hooked material as prescribed by Applicant's claims is legally and factually wrong. If it were, it would work.

15. **FACT** - Neither the ball retrieving attachment nor the hooked material as defined by *Feldi* perform the same function as Applicant's narrowly defined and unusual hooked material and, therefore, it cannot be regarded to be the equivalent to the claimed ball retrieving attachment or hooked material of Applicant's claims. The mere fact that a product brand is called a SCOTCHMATE does not render it *ipso facto* equivalent, since as shown by the Applicant's Affidavit, the SCOTCHMATE mushroom type fasteners do not work as well as most others.

16. **FACT** - Inherency cannot be presumed but must be proven by the prior art, not Applicant's contribution, M.P.E.P. 2112.

Musslin Facts

1. **FACT** - The teachings of the *Feldi* patent (filed December 27, 1987 and patented May 30, 1989) rest upon technology known after the *Musslin* patent teaching and, therefore, *Feldi* summarizes the state of the known art as of the registration date (02/07/1986) of the *Musslin* patent. (i.e. Velcro or any other monofilament hooked materials will not tangentially engage and lift tennis balls.)

2. **FACT** - The *Musslin* patent fails to provide any information as what constitutes a suitable cloth (wrapper) with hooks (including metal fastening threads) which may be used in the French patent.

3. **FACT** - The *Musslin* patent fails to provide any enabling teachings (i.e. 35 U.S.C. 112) so as to enable anyone of ordinary skill to make and use a non-enabling substance of the *Musslin* invention.

4. **FACT** - *Feldi* teaches that the VELCRO hook materials do not work

5. **FACT** - *Musslin* neither discloses nor remotely teaches use or Applicant's claimed ball retrieving attachment comprising "hooked fastener material having a series of pre-shrunk nylon monofilaments ... of ... "an average diameter greater than 8.0 mil and an average hook height of at least 1.70 mm (claims 1-9) or the method claim 10 limitation of an average:

- height of at least 1.85 mm (also claims 4-8 and 10-15)
- diameter of at least 8.25 mil (also claims 4-8 and 10-15)
- hook width of at least 1.0 mm (claims 4-8 and 10-15)
- depth of at least 0.6 (claims 4-8 and 10-15)
- at least 300 hooks per inch squared (claim 9)
- at least 250 hooks (claim 10)

6. **FACT** - *Musslin* leaves the artisan completely in the dark as to what works and what does not work which in light of the *Feldi* teachings indicates *Musslin* is nothing more than a paper conceptual patent leaving the artisan to a myriad of potential applications, as taught by both *Urwin* and *Feldi*, which don't work (without increasing significantly the surface area of contact) as evidenced by both the *Feldi* and *Urwin* patent teachings.

7. **FACT** - The essential elements of applicant's claimed ball retrieving attachment and hooked material are not disclosed by *Musslin*.

Urwin Facts

1. **FACT** - *Urwin* does not disclose the embodiments of applicant's invention, nor does *Urwin* teach that one would succeed through the means of tangentially contacting, engaging and lifting a tennis ball with the narrowly defined ball retrieving attachment of hooked materials as prescribed by applicants claims 1-15.

2. **FACT** - *Urwin* teaches precisely the opposite from Applicant's "tangential contacting" by stating that "a strip which follows the contour of the head of the tennis ball racquet has a curve diametrically opposite to the curve of the tennis ball, *meaning that only one small area of the strip can come in contact with the tennis ball, making it very unlikely that the ball can be grasped securely enough to be picked up.*" (for example, see Column, 2, Lines 1-10)
3. **FACT** - *Urwin* states that the most appropriate place "where the apparatus provides a means to attempt to grasp the tennis ball and that is at the butt end of the handle of the tennis racquet." (Column 1, Lines 61-64).
4. **FACT AND FICTION** - The Examiner's reliance upon Col. 4, lines 8-13 of *Urwin* is wrong since the cup shaped ball retriever 10 of Figure 3 includes a base having a Velcro strip 24 which allows the cup shaped retriever 10 to removable attached to the Velcro strip 30 referenced in Col. 4, lines 8-13. The Velcro strip 30 of Figure 1 does not pick up the ball, but serves only as a mount for ball retriever 10 of *Urwin*..
5. **FACT** - The essence of the patented invention of *Urwin* relies upon increasing the surface area of hooked material contact with the tennis ball by providing a cup shaped retriever 10 which engages over a large portion of the tennis ball surface and thereby provides sufficient arcuate surface contact along almost one-half of the radial surface of the tennis ball pile so as to permit the tennis ball to be lifted thereby.
6. **FACT** - The applicant's claimed invention of tangentially contacting, engaging and lifting of the tennis ball cover with the unique claimed tennis ball attachment is completely contradictory to the ball encompassing teachings of *Urwin* and *Urwin*'s clear teachings that such an approach would make it very unlikely to effectively grasp and pick up the tennis ball.
7. **FACT** - Applicant's claimed invention relies upon entirely different principles and mode of operation from that disclosed by *Urwin*. (Cupping vs. tangential contacting and lifting.)
8. **FACT** - The cup shaped ball retriever of *Urwin* is an essential embodiment and teaching of the *Urwin* patent. Accordingly, it would be impermissible when relying upon *Urwin* to

completely disregard the need and functional purpose of an encompassing cup which provides sufficient surface area so that the ball may be lifted and retrieved thereby.

9. **FACT** - Applicant's tangential contacting completely contradicts the engaging cup teachings of *Urwin*, and therefore, *Urwin* clearly teaches and directs the artisan away from the embodiments of Applicant's claims 1-15.

10. **FACT** - The invention as described by *Urwin* would be rendered inoperative by the replacement of the cup shaped ball retainer with the tangential contacting engaging and lifting embodiments of Applicant's claimed invention.

11. **FACT** - Applicant's tangential contacting and lifting embodiments are totally unexpected in view of *Urwin*'s teachings.

Melbye Facts

1. **FACT** - The *Melbye* mushroom type hook strip is not a "hooked fastener material having a series of preshrunk nylon monofilament hooks... characterized as having a monofilament diameter greater than 8 mil and an average height of at least 1.70 mm." Applicant's claimed hooked material is totally different, as clearly defined by claims 1-15.

2. **FACT** - The *Melbye* (SCOTCHMATE) mushroom hook strip when applied as a hooked fastener does not work as clearly evidenced by Applicant's Rule 132 Affidavit.

3. **FACT** - The *Melbye* mushroom type hook strip is not an actual and obvious equivalent to the unique and distinctly monofilament nylon hook fastener materials as defined by Applicant's claim. (Equivalent must perform the same functional result.)

4. **FACT** - Just because 3M classifies a host of different fasteners as being sold under the SCOTCHMATE label does not mean that all SCOTCHMATE products are the actual and obvious equivalent to one another as evidenced by Applicant's 132 Affidavit.

5. **FACT** - To apply *Melbye* as a 103 reference would require a total disregard of the essence of the *Melbye* patent, (i.e. replace the mushroom type fastener with an unrelated and completely different monofilament fastener of totally unrelated hook characteristics.)

EQUIVALENCY FICTION

1. **FACT** - Applicant has never acquiesced or stated that the ball retrievers disclosed by the prior art are the equivalents (actual and obvious) to Applicant's ball retriever attachment of the hooked monofilaments of the highly specified structure and characteristics as prescribed by Applicant's claims.
2. **FACT** - Applicant's Rule 132 Affidavit refutes in total the Examiner's unwarranted and unsubstantiated assertion that all SCOTCHMATES and all fasteners are the actual and obvious equivalents to one another including Applicant's unique ball retriever attachment..
3. **FACT** - Contrary to the Office Action's assertion, there exists a host of different types of fasteners which heretofore were recognized by the art of record as incapable of tangentially engaging and lifting a tennis ball therewith, and that pursuant to these prior art teachings, tennis ball lifting efficacy could only be accomplished by increasing the contacting surface in a cup-wise fashion so as to provide sufficient contact with the ball so as to permit the hook fasteners to lift the ball thereby (*Urwin*) or by changing the ball to a hook or loop covering (*Feldi*).
4. **FACT** - Equivalency is clearly refuted by the cited art of record which clearly states that the Velcro fasteners as used and applied by the prior art were incapable of providing the unexpected tangential contacting engaging and lifting attributes of Applicant's ball retrieving attachment of claims 1-15. As a general rule, SCOTCHMATE fasteners of the Velcro type do not work. The uniqueness of the Applicant's ball retrieving attachment of precise monofilament fiber hook character as claimed herein provides a totally new and unexpected result within an art background consistently believing that it could not be done.
5. **FACT** - If none of the references of record disclose or define a ball retrieving attachment with a monofilament hooked fastener as uniquely claimed herein which uniquely permits tangential contacting and lifting of a tennis ball therewith, there cannot be any equivalency when, in fact, all of the references relied upon failed to disclose these unique embodiments of Applicant's invention in sufficient detail so as to enable anyone of ordinary skill to make and use Applicant's invention.

6. **FACT** - Equivalency cannot be predicated upon an unexpected and unique function totally absent from all other functions relied upon and alleged to be equivalent.

NO PRIMA FACIE CASE OF OBVIOUSNESS EXISTS

The 35 U.S.C. 103 rejection of record disregards the obviousness patentability guidelines as set forth in Chapter 2100 of the M.P.E.P.. The final rejection appears to rely upon a mystical alleged factual conclusion that just because a SCOTCHMATE is known, then all fastener combinations amongst a vast number of different selections from a wide array of potential sources would be obvious to one of ordinary skill. In essence, the final rejection appears to distill the invention to a certain jest or thrust of the invention which, in turn, disregards the well established requirement of analyzing the subject matter as a whole. Before there can be any resolution whatsoever of the 35 U.S.C. 103 rejection, it is imperative that the invention as a whole, and not some part of it, must be obvious. *In re Antonie*, 559 F.2d 618, 620, 195 USPQ 6,8 (CCPA 1977). The claimed subject matter, as a whole, includes tangentially contacting and lifting a conventional tennis ball which, *ipso facto*, includes the tennis ball felt covering with a highly specified ball retrieving attachment of a monofilament nylon hooked material of very limited and specific characterizations.

To establish *prima facie* obviousness of a claimed invention, **all the claim limitations must be taught or suggested by the prior art**, as stated in M.P.E.P. 2143.03. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). All words in a claim must be considered in judging the patentability of that claim against the prior art." "In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). If an independent claim is non-obvious under 35 U.S.C. 103, then any claim depending therefrom is non-obvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)."

Clearly, the only basis for alleging all of the claimed limitations of Applicant's claims have been met by the prior art rests solely upon a totally unsupported allegation that the Applicant has admitted equivalency to the highly specific and precise ball retrieving attachment of claimed hooked fasteners herein to those taught by the prior art as relied upon in the 35 U.S.C. 103

rejection. Applicant strenuously objects to such a strained and totally unwarranted conclusion that the Applicant has admitted equivalency between the claimed subject matter of this invention and the prior art. It does not exist. There is no support for such an unfounded assertion and it should be withdrawn for total want of factual and legal justification. Within a somewhat analogous situation the M.P.E.P. under section 2401.02 recognizes this fallacy by stating,

“The prior art did not recognize that treatment capacity was a function of the tank volume to contractor ratio, and therefore the parameter optimized was not recognized in the art to be a result-effective variable. The prior art did not recognize and, in fact, failed to teach the very limited and highly specific parameters of the hooked materials (as a whole) as claimed herein by the Applicant would lend to a totally unexpected result precisely opposite from what the cited patents teach.”

Again, the Applicant reiterates the fact that the characterizations of the ball retrieving attachment and monofilaments as precisely claimed herein are totally absent from anything cited or made of record by the Examiner in the 35 U.S.C. 103 rejections herein. In fact, the equivalency as alleged to be established by the *Melbye* patent is completely inoperable when applied to the tangential contacting and lifting requirements of Applicant's invention, which fact remains irrefuted and clearly substantiated by Applicant's Rule 132 Affidavit. Under the patentability requirements of 2141.02 it is stated , “A prior art reference must be considered in its entirety, i.e. as a whole, including portions that would lead away from the claimed invention. *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984). The *Gore* decision acknowledged this by holding that a reference teaching rapid stretching of conventional plastic polypropylene with reduced crystallinity combined with a reference teaching stretching unsintered PTFE would not suggest rapid stretching of highly crystalline PTFE, in light of the disclosures in the art that teach away from the invention, i.e., that the conventional polypropylene should have reduced crystallinity before stretching, and that PTFE should be stretched slowly.”

PRIMA FACIE OBVIOUSNESS MUSTS

Section 2143 of the M.P.E.P. makes it succinctly clear that three basic criteria must be met in order to establish a *prima facie* case of obviousness. It is unequivocally clear herein that these three basic criteria have not been met. These criteria are as follows:

“To establish a *prima facie* case of obviousness, three basic criteria must be met. **First, there must be some suggestion or motivation**, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, **to modify the reference or to combine reference teachings**. **Second, there must be a reasonable expectation of success**. **Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations**. All of these elements are lacking in the Final Rejection.

The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).” Only Applicant's claimed invention herein unlocks the inoperability of the prior art endeavors.

The final rejection appears to rest upon the premise that references may be arbitrarily combined by simply randomly gleaning discordant teachings from each of the cited references and then forcibly combining those discordant teachings (notwithstanding clear teachings otherwise) in such a manner so as to meet the claimed limitations of Applicant's invention. Unfortunately, even when all this is done, there is still lacking a teaching reference or patent teaching of the unique ball retrieving attachment of precise monofilament hook characteristics of Applicant's claims which for want of any other justification is assumed to be equivalent because the Applicant allegedly admitted equivalency. References can only be combined if there exists a suggestion or motivation in the references to do so, M.P.E.P. 2143.01.

**FACT THAT REFERENCES CAN BE COMBINED OR MODIFIED IS NOT
SUFFICIENT TO ESTABLISH *PRIMA FACIE* OBVIOUSNESS**

The final rejection clearly falls within the ambit of: “A statement that modifications of the prior art to meet the claimed invention would have been “ ‘well within the ordinary skill of the art at the time the claimed invention was made’ ... “ because the references relied upon teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish a *prima facie* case of obviousness without some objective reason to combine the teachings of the references. *Ex parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993). See Also *Al-Site Corp. v. VSI Int'l Inc.*, 174 F.3d 1308, 50 USPQ2d 1161 (Fed. Cir. 1999) (The level of skill in the art cannot be relied upon to provide the suggestion to combine references.)”

Applicant has taken great care to point out above, as well as in Applicant's previous response that, “If a proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984)...” (N.B. *Urwin*, *Feldi*, *Musslin*, etc.)

Chapter 2100 of M.P.E.P. also makes it explicitly clear that when references are combined with one another so as to modify a reference, then the proposed modification cannot change the principle of operation of the modified reference. Clearly, the manner in which the references have been applied against Applicant's claims must necessarily change the principle of operation of the reference so that it no longer functions in its intended manner. (e.g. *Feldi*, *Urwin* and *Melbye*).

The decision *in re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959) is pertinent in that therein the claims were directed to an oil seal comprising a bore engaging portion with outwardly biased resilient spring fingers inserted in a resilient sealing member. The primary reference of *Ratti* relied upon in a rejection was based on a combination of references disclosing an oil seal wherein the bore engaging portion was reinforced by a cylindrical sheet metal casing. The *Ratti* patentee taught the device required rigidity for operation, whereas the claimed invention required

resiliency. It is rather interesting that the Court of Customs and Patent Appeals, in reversing an Examiner's obviousness rejection, held that the suggested combination of references would require a substantial reconstruction and redesign of the elements shown in [the primary reference] as well as a change in the basic principle under which the [primary reference] construction was designed to operation. The final rejection herein rests upon the same fallacy.

As pointed out previously, Section 2143.03 requires that all of the claimed limitations must be taught or suggested by the prior art. "To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). Similarly, 'all words in a claim must be considered in judging the patentability of that claim against the prior art.' *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). If an independent claim is non-obvious under 35 U.S.C. 103, then any claim depending therefrom is non-obvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)."

Lastly, there has not been any consideration whatsoever given to the secondary objective evidence of record. Section 2141 requires that "OBJECTIVE EVIDENCE MUST BE CONSIDERED. Objective evidence or secondary considerations such as unexpected results, commercial success, long-felt need, failure of others, copying by others, licensing, and skepticism of experts are relevant to the issue of obviousness and must be considered in every case in which they are present. When evidence of any of these secondary considerations is submitted, the examiner must evaluate the evidence of Section 2141."

METHOD CLAIMS 10-15

Method Claims 10-15 have not been rejected upon any prior art which suggest or motivate the artisan to modify the references as proposed in the Office Action (must totally revamp the patents to eliminate essential teachings and functions totally different, such as cup of *Urwin* or

replace the wool pile with a nylon fastener of *Feldi* ³) in light of explicit teachings stating that what the Applicant has done will not work, (e.g. reasonable expectation of success.) ⁴

Then there exists the remaining *prima facie* criteria that the prior art references (not Applicant's teachings) must teach and suggest all the claimed limitations.⁵

There exists hundreds of different patents relating to a host of different types of fasteners, including those of a pedestal and mushroom type as well as nylon filament hook types. A host of differences exist within the broad and all encompassing field. Patents are issued upon patentable versions of these fasteners and their manufacture on a consistent basis. In addition, there exists a wide array of different manufacturers who produce different fastener combinations under different labels. The field is not so limited as the Office Action would tend to suggest which should be self-evident by the failure of the final rejection to cite even one patent or reference possessing the uniquely different claimed characteristics of Applicant's ball retrieving attachment herein. The field is vast and there exists no teaching or suggestion of record directing or motivating the artisan towards a unique claimed ball retrieving attachment of a highly specialized characteristic which accomplishes a feat (tangential contacting and lifting a tennis ball) which others (i.e. 35 U.S.C. 103 patents of record) said could not be achieved. Is there not clear patentability under 35 U.S.C. 103 to discover an unknown ball retrieving attachment of an unknown ball retrieving function to produce an unknown and unexpected result which is most astounding in view of clear 35 U.S.C. 103 patent teaching stating it cannot be done. The prior art solutions are diametrically opposed (e.g. change ball cover and make cupped retrieving attachment) to Applicant's unexpected discovery and results, and the art taught futility of Applicant's solution to a long felt need, all add further objective evidence of the patentability of the claimed method claims herein. Obviousness cannot be predicated upon what was heretofore unknown. Applicant's providing a ball retrieving

3. Step 1 of obviousness criteria per M.P.E.P. 2141

4. Step 2 of obviousness criteria per M.P.E.P. 2141

5. Step 3 of obviousness criteria per M.P.E.P. 2141

attachment of uniquely different claimed characteristics, applying the unique ball retriever to the tennis racket shoulder and tangentially contacting and lifting the grounded tennis ball is unique, heretofore not possible and clearly patentable under the M.P.E.P. 35 U.S.C. 103 criteria.

me One cannot reconcile Applicant's method Claims ¹⁹1-15 with the very prior art relied upon in rejecting Applicant's claims. *Urwin* may attach a strip of a totally different hook and loop fastener to a shoulder of a tennis racquet for a totally different purpose of removeably attaching the cupped shaped ball retriever thereto. In *Urwin*, only the cupped shaped ball retriever retrieves the ball. In *Feldi*, only the hook-loop combination involving changing the ball cover to either a hook or loop and relying upon the other to retrieve the ball serves to retrieve a non-tennis ball therewith. The rejection of the method claims ¹⁰1-15 **SHOULD BE WITHDRAWN.**

CONCLUSION

me The final rejection involves a creative reconstruction of the prior art in a manner completely contradictory to the very references relied upon. The reliance upon Applicant's admission of equivalency is factually and legally wrong. The mere fact VELCRO and SCOTCHMATE may be regarded as hook-and-loop fasteners does not mean that equivalency exists. On page 3, paragraph 2 the Office Action wrongly concludes equivalency upon *Melbye's* Col. 1, line 15-18 teachings of "widely used garment fasteners are hook-and-loop fasteners such as currently marketed under the trademark Velcro by Velcro U.S.A., Inc., and under the trademark SCOTCHMATE by 3M Company." The Office Action misses the whole point of the doctrine of equivalency meaning that actual and obvious equivalency does in fact exist. Actual equivalency means that they function in the same manner to produce the same result. The product as defined by *Melbye* may be a SCOTCHMATE which, as clearly stated in Applicant's Rule 132, is neither the actual or obvious equivalent of the highly unique and specialized monofilament hooked material as prescribed by Applicant's claims. **It does not work, it does not function.** None of the teachings of record remotely disclosed or contemplated the untaught embodiments of Applicant's invention. Obviousness cannot be predicated upon what is unknown and uncited.

Neither *Musslin*, *Urwin* nor *Feldi* disclose or suggest that VELCRO or SCOTCHMATE may be used to tangentially contact and lift a tennis ball. If you modify the ball so it either contains Velcro hooks or loops instead of the tennis ball felt cover so the combined hook or loop lifts the ball or to more completely encircle or cup the ball (*Urwin*), then it will work, BUT neither of these embodiments constitute Applicant's claimed invention.

The reliance of column 4, lines 8-13 that "the hook fastener may be placed anywhere along the outer surface of the racquet frame" of *Urwin* arises from a failure to read *Urwin* for what it teaches. The Velcro strips mentioned in Col. 4, lines 8-13 refer only to the placement of hook and loop strip onto which the cupped shaped ball retrieving attachment 10 or "arcuate shaped gripping member 40 is removeably affixed to the gripping means by gripping means 24 which are hook Velcro fastener." As stated, "the tennis ball fits snugly within the interior of arcuate shaped gripping member 10." The gripping means 10 as shown in Figure 3 of *Urwin* may be attached anywhere where there is a fastening strip for it to be attached. One should read and understand the patent's teaching before choosing a passage which bears no relevancy to what the patent teaches as a whole.

Accompanying this response is a copy of a response received from Wilson Sporting Goods which should put an end to the Office Action's strained construction "that the claims do not preclude changing the tennis ball pile." If that were done as taught by *Feldi*, it would no longer be a tennis ball. For whatever reason the Office Action deems it necessary to reject Applicant's claims based on conclusions which are contrary to the very patent teaching relied upon, Applicant respectfully requests an examination of each of the patent teachings, as a whole, and not by a random gleaning of only those isolated and disjointed teachings which support a rejection at the exclusion of those teachings needed to understand what the art fairly teaches and suggests to the artisan.

There exists no factual basis under 35 U.S.C. 103 to reject Applicant's claims 1-15 herein. The final rejection recognizes the want of such facts and attempts to rely upon erroneous conceptions to provide what is factually and legally wanting. The M.P.E.P. guidelines as to what

constitutes a proper 35 U.S.C. 103 rejection has not even been taken into account. The final rejection is **WRONG**. Applicant's claimed invention is truly unexpected and patentable since the very art relied upon by the Examiner in the final rejection clearly states it cannot be done.

Applicant's attorney believes that this response should place Applicant's application in condition for allowance. If for any reason the application is not considered to be in condition for allowance, Applicant's attorney requests a telephone interview with Examiner Chiu so as to discuss the merits of the application. Drawing informalities, if any, are requested to be held in abeyance until the Notice of Allowance. Applicant's prior Responses are incorporated herein as part of this Response.

The Applicant respectfully submits that the pending claims comply with the 35 U.S.C. 112 requirements, define novel and unobviousness subject matter over the art of record, and place the claims in condition for allowance. Reconsideration and early allowance of the application is respectfully requested.

Dated this 18th day of April, 2002.

Respectfully submitted,

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